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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,688	09/30/2003	David J. Park	66329/31349	6172
23380 7590 06/11/2009 TUCKER ELLIS & WEST LLP 1150 HUNTINGTON BUILDING 925 EUCLID AVENUE CLEVELAND, OH 44115-1414				
EXAMINER ROBINSON, MYLES D				
ART UNIT		PAPER NUMBER		
2625				
NOTIFICATION DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents@tuckerellis.com
christopher.luoma@tuckerellis.com

Office Action Summary

Application No.

10/675,688

Applicant(s)

PARK ET AL.

Examiner

Myles D. Robinson

Art Unit

2625

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 3, 6 - 11 and 14 - 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 - 3, 6 - 11 and 14 - 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 May 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Paper No(s)/Mail Date _____
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on 3/18/2009, and has been entered and made of record. Currently, **claims 1 – 3, 6 – 11 and 14 – 16** are pending.

Response to Arguments

2. Applicant's arguments (*see Remarks 3/18/2009 [page 7, lines 1 – 9] and Interview Summary 3/17/2009*) with respect to the rejections of **claims 1 – 3, 6 – 11 and 14 – 16** under 35 U.S.C. §102(b) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of **Johnson et al.** (U.S. Patent No. 5,267,303) which expressly incorporates by reference **Cooper et al.** (U.S. Patent No. 5,448,375) (*see column 14, lines 24 – 30 of Johnson*).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1 – 3, 6 – 11 and 14 – 16** are rejected under 35 U.S.C. 103(a) as being unpatentable over **McGraw** (U.S. Patent No. 6,542,261) in view of **Mooney et al.** (U.S. Patent No. 6,980,331) and further in view of **Johnson et al.** (U.S. Patent No. 5,267,303)

which expressly incorporates by reference **Cooper et al.** (U.S. Patent No. 5,448,375) (*see column 14, lines 24 – 30 of Johnson*).

To anticipate a claim under §102(a), (b), and (e), the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). However, instead of repeating some information contained in another document, an application may attempt to incorporate the content of another document or part thereof by reference to the document in the text of the specification. The information incorporated is as much a part of the application as filed as if the text was repeated in the application, and should be treated as part of the text of the application as filed. See MPEP 2131, 2163.07(b).

Since Johnson has incorporated by reference the teachings of Cooper, the same, exact information is considered as fully disclosed as a part of Johnson as filed. Therefore, the single prior art reference of Johnson is capable of teaching each and every element of the claims.

Referring to **claim 1**, McGraw discloses a system for processing of electronic documents comprising:

image generating means (*see Fig. 1, multifunction printer/FAX machine 12*) for generating an electronic representation of a paper document (*see Fig. 1, document 28 [column 2, lines 53 – 55 and column 3, lines 33 – 45 and 49 – 52]*),

the image generating means including means for receiving an associated tangible template sheet (see Fig. 3 wherein the control form [e.g. cover sheet] is analogous to a tangible template sheet inclusive of a plurality of indicia [i.e. checkboxes] corresponding to instructions [column 5, lines 52 – 56 and column 6, lines 22 – 24]) inclusive of a plurality of handwritten indicia (see Fig. 3 wherein the Note section comprises handwritten characters to be scanned [column 5, line 61]) corresponding to an instruction for a desired document processing operation (see Fig. 3 wherein the checkboxes within the sections Resolution [e.g. standard, fine], Copy/Scan Type [e.g. black/white, color, resolution modes such as draft, normal and best] and Copy Setting [e.g. copy size, quantity, collation] are analogous to desired document processing operations) and indicia indicative of an instruction specifying an electronic document format for the electronic document (see Fig. 3 wherein the checkboxes within the section Scan Setting [e.g. BMP file, JPG file, TIFF file] is analogous to selected electronic document formats),

optical recognition means for recognition of the instructions (column 5, lines 54 – 56, column 6, lines 18 – 20 and 22 – 24),

means for generating an instruction signal in accordance with a recognized instructions (column 5, lines 52 – 60, column 6, lines 18 – 20, 22 – 24, 39 – 46 and 57 – 62 wherein the system produces a secure FAX based upon the user's selections on the control form of Fig. 3),

means for controlling operation of an associated document processing device on the electronic representation of the paper document in accordance with the instruction

signal so as to generate an electronic document in the specified electronic document format (see Fig. 6 wherein steps S20, S28 output the secured FAX document in accordance to the boxes checked [column 5, lines 52 – 60, column 6, lines 39 – 46 and 57 – 62]),

means for generating an output document in accordance with the controlled operation (see Fig. 6, steps S20, S28 [column 3, lines 1 – 6, column 6, lines 39 – 46 and 57 – 62]), and

means for communicating the output document in the specified electronic document format (see Fig. 1 wherein the scanned document 28 is transmitted via communication system 16 [column 3, lines 36 – 40]) to a destination in accordance with the instruction signal (see Fig. 3 wherein the section Fax Settings To: is analogous to a specified destination [column 5, lines 61 – 64]) but does not explicitly disclose the system further comprising an associated tangible template sheet inclusive of a plurality of handwritten indicia corresponds to an instruction for a desired document processing operation including, e-mail transmission, storage operation, and facsimile transmission, characters indicative of a desired recipient for an electronic document, characters indicative of a storage location folder name for electronic data storage, characters indicative of a return address of sender, optical character recognition means for generating character data from the characters, means for generating a confirmation display in accordance with the character data, means for receiving confirmation input from an associated user in accordance with the confirmation display, means for generating an instruction signal in accordance with the received confirmation input, and

means for communicating the output document in the specified electronic document format to a destination in accordance with the character data.

Mooney discloses the system comprising:

an associated tangible template sheet inclusive of a plurality of handwritten indicia corresponds to an instruction for a desired document processing operation including, e-mail transmission and facsimile transmission, characters indicative of a desired recipient for an electronic document (*see Figs. 1 – 2 wherein the recipient's fax number is handwritten in the a predefined region of the page 120, detected, recognized and converted to textual information for electronic transmission [column 4, lines 40 – 44, 49 – 52 and 53 – 57] and likewise in Figs. 3A – 5 wherein a recipient's e-mail address and/or fax number is written in predefined areas 320 [Title, Abstract, column 7, lines 7 – 13, column 8, lines 12 – 18, 38 – 46 and column 8, line 63 – column 9, line 3]*), comprising:

optical character recognition means for generating character data from the characters (*see Fig. 2 for fax numbers in step 208 [Abstract, column 2, lines 57 – 61, column 4, line 66 – column 5, line 3 and column 10, lines 10 – 11] and see Fig. 5 for e-mail addresses in step 508 [Abstract, column 2, lines 57 – 61, column 9, lines 28 – 32 and column 10, lines 10 – 11]*),

means for generating a confirmation display in accordance with the character data (*see Fig. 1 wherein fax machine 190 displays the detected, recognized and textually converted recipient's telephone number for confirmation by the user before the outgoing fax is made [column 5, lines 49 – 56]*),

means for receiving confirmation input from an associated user in accordance with the confirmation display (*Abstract and column 6, lines 46 – 52 wherein error processing may allow the user to erase and rewrite the recipient's fax number or e-mail address*),

means for generating an instruction signal in accordance with the received confirmation input (*Abstract and column 6, lines 46 – 52 wherein the user's final confirmation of the rewritten recipient's fax number or e-mail address before sending the message is analogous to the instruction signal in accordance with received confirmation input*), and

means for communicating the output document in the specified electronic document format to a destination in accordance with the character data (*Abstract, column 3, line 64 – column 4, line 3 and column 7, line 64 – column 8, line 3 wherein the message is either faxed or electronically mailed*) but does not explicitly disclose the system further comprising an associated tangible template sheet inclusive of a the plurality of handwritten indicia corresponds to an instruction for a desired document processing operation including storage operation, characters indicative of a storage location folder name for electronic data storage, and characters indicative of a return address of sender.

Johnson discloses the system comprising:

an associated tangible template sheet inclusive of a plurality of handwritten indicia (*column 6, lines 15 – 35 wherein a user's marks are equivalent to a user's handwritten indicia*) corresponds to an instruction for a desired document processing

operation (column 6, line 49 – column 7, line 4 wherein the mark indicates a request for an operation is equivalent to handwritten indicia corresponding to an instruction for a desired document processing operation) including storage operation (column 13, lines 54 – 56, 58 – 59 and column 14, lines 16 – 30 wherein the Store action is the equivalent of a storage operation and wherein Cooper, which is incorporated by reference, further teaches a storage operation using handwritten indicia),

characters indicative of a storage location folder name for electronic data storage (see Fig. 5 wherein information database 322 includes a list of categories [i.e. folders] of documents which include pointers to the name of the DOS file in which data defining the document is stored [column 11, lines 22 – 24 and 34 – 39] and includes a hierarchy, with leaf nodes being items related to specific documents and with parent nodes being containers, wherein such hierarchy of parent containers and leaf nodes is equivalent to a nested system of folders comprising documents as well as other sub-folders [column 18, lines 34 – 63]), and

characters indicative of a return address of sender (see Fig. 7 wherein form 500 comprises return address segment 510 for the user to write in a fax machine's telephone number [i.e. characters] [column 15, lines 25 – 29, column 17, lines 37 – 41 and column 18, lines 8 – 30]).

Cooper further discloses the system further comprising:

an associated tangible template sheet inclusive of a plurality of handwritten indicia corresponds to an instruction for a desired document processing operation including storage operation, and characters indicative of a storage location folder name

for electronic data storage (*Title, Abstract, column 3, line 51 – column 4, line 15 and column 15, lines 46 – 50 wherein a special cover form, which comprises a region in which the user handwrites the file name [i.e. image domain label], is scanned along with a document to create an electronic data file associated file name for storing in a category [i.e. folder] and then establishes a relationship by way of data base entries [i.e. association between the location of the file and the file name] between the handwritten user file name [i.e. image domain label] and the data representing the document*).

McGraw, Mooney and Johnson are combinable because they are from the same field of endeavor, being optical character recognition-assisted facsimile systems. At the time of the invention, it would have been obvious to one of ordinary skill in the art to include displaying the recipient's fax number and/or e-mail address for confirmation prior to sending messages along with such facsimile systems. The suggestion/motivation for doing so would have been to prevent messages from being sent to the wrong destinations as well as easily saving confirmed fax numbers into speed dial for future use, as suggested by Mooney (*column 1, lines 29 – 52, column 2, lines 2 – 6 and column 6, lines 34 – 52*).

Furthermore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include allowing a user to write in their return address. The suggestion/motivation for doing so would have been to allow the user to request that the newly created form be transmitted to the fax machine where the user is located or to another fax machine of his/her discretion, as suggested by Johnson (*column 18, lines 8 – 13*).

Furthermore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include allowing the user to write in a storage location folder name (i.e. file name) when electronically storing a document. The suggestion/motivation for doing so would have been to the user to assign a meaningful, easily-remembered user-selected file label, such as labels using foreign language characters, for a file which more easily and directly allows the user to identify a desired file in a system lacking a text entry device (e.g. keyboard, keypads, etc.), as suggested by Cooper (*column 2, line 3 – column 3, line 50*).

Referring to **claims 2 and 3**, McGraw discloses the system further comprising means for identifying a location of relevant markings on the template sheet,

wherein the means for identifying the location of relevant markings comprised as at least one of check boxes and fill-in boxes (*see Fig. 3 wherein the checkboxes are analogous to locations of relevant markings*).

Referring to **claim 6**, McGraw discloses the system further wherein the output document is communicated via at least one of electronic mail transmission, facsimile transmission, FTP transmission, HTML transmission, and optical image rendering on an associated display (*see Fig. 1 wherein communication system 16 and connection 18 work in conjunction as either a telephone system or internet communication system [column 3, lines 36 – 40]*).

Referring to **claim 7**, McGraw discloses the system further wherein the output document is communicated to at least one of an electronic mail server, a document management system, an image generating device, and an Internet server (*see Fig. 1*

wherein communication system 16 and connection 18 work in conjunction as either a telephone system or internet communication system [column 3, lines 36 – 40] wherein such systems inherently include servers and see Fig. 1 wherein either computer 32 or multifunctional printer/FAX machine 30 produces the secure FAX [column 4, lines 32 – 36]).

Referring to **claim 8**, McGraw discloses the system further comprising verification means for verifying the desired document processing operation (*see Fig. 6, step S26 [column 5, lines 37 – 51 and column 6, lines 53 – 56]*).

Referring to **claims 9 – 11 and 14 – 16**, the rationale provided in the rejections of claims 1 – 3 and 6 – 8, respectively, are incorporated herein. In addition, the systems of claims 1 – 3 and 6 – 8 perform the methods of claims 9 – 11 and 14 – 16, respectively.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kuo (U.S. Patent No. 5,295,181) discloses an automatic facsimile output recipient telephoning system which discusses the PaperWorks™ fax form in the background of the invention (*column 5, line 21 – column 6, line 12 and column 6, line 55 – column 7, line 29*).

Johnson et al. (U.S. Patent No. 5,060,980) disclose a form utilizing encoded indications for form field processing (*see Abstract and Figs. 1 – 5*).

Johnson et al. (U.S. Patent No. 5,282,052) disclose techniques for automatic form creation by combining partial operations (*see Abstract and Figs. 1 – 8*).

Johnson (U.S. Patent No. 5,745,610) discloses data access based on human-produced images such as marking marks by hand (*see Abstract and Figs. 1 – 15*).

Crabb "Xerox PaperWorks mates fax, PC in terrific product" discusses the PaperWorks™ fax form.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Myles D. Robinson whose telephone number is (571)272-5944. The examiner can normally be reached on M-F 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler L. Haskins can be reached on (571) 272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Myles D. Robinson/
Examiner, Art Unit 2625
6/3/09

/Twyler L. Haskins/
Supervisory Patent Examiner, Art Unit 2625